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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,966	03/19/2002	Hiromi Ukai	62807-015	7234

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EXAMINER

CARLSON, JEFFREY D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/099,966

Applicant(s)

UKAI ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11,13,15,17,20,21 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11,13,15,17,20,21 and 23-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/948,698.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/6/03, 8/19/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the paper(s) filed 5/1/06.
2. The amendment filed 5/1/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- There is no support for (claims 32, 33) the program guide providing the identifier for the broadcast to the receiver, whereby the receiver then attaches that identifier to the service center as part of the coupon request. Although page 11 of the specification mentions the guide, there is no disclosure that the guide provides the identifier to be attached as part of the coupon request.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 11, 13, 15, 17, 20, 21, 23-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- Claims 11, 13, 15, 17, applicant is claiming performance of method steps (service center managing) rather than programmed features/capabilities of the system apparatus.
- Claims 32, 33, applicant is claiming performance of method steps (receiver obtains...by referring to) rather than programmed features/capabilities of the system apparatus.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 11, 13, 15, 17, 20, 21, 23-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holman (US5287181) in view of Lemon et al (US4674041) and Kitsukawa et al (US6282713).**

Regarding claims 11, 13, 15, 17, 29, Holman teaches a system and methods for broadcasting coupon information to users along with programming or commercial messages [abstract, 6:5-23]. A message is displayed to the user informing him of the existence of a coupon related to the program/commercial being viewed. When the user is interested, he may request that the coupon be stored locally for later redemption. Holman does not appear to teach the concept of tracking the number of issued coupons. Lemon et al teaches an electronic coupon kiosk where users are informed of

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the existence of certain coupons and they may request that certain coupons of interest to the user be downloaded locally for later redemption. Lemon et al also teaches that manufacturers may specify limits regarding the number of coupons to be issued and the system enforces such limits [col 1 lines 55 to col 2 lines 20, col 3 lines 39-57, col 26 lines 37-51]. It would have been obvious to one of ordinary skill at the time of the invention to have informed a service center for tracking and managing the number of requested/issued coupons of Holman so that the manufacturer's limits can be enforced. Although Holman appears to encode the coupon data with a field to denote the coupon source (publication/broadcast log), Kitsukawa et al however also teaches delivery of electronic coupons to users via broadcast television content. Kitsukawa et al teaches that the user can be notified of the availability of a coupon, that the user can select the coupon and more clearly teaches that the system will store information concerning the broadcasted content when the coupons were delivered [11:48-54]. The central host includes storage of these coupon identifiers along with the broadcast content information [12:9-20] to allow for "statistical television data." It would have been obvious to one of ordinary skill at the time of the invention to have included such means for storing history with the modified system of Holman so that statistics could be provided regarding coupon activities (issuances and redemptions) with respect to each tracked broadcast. The system would continue to broadcast availability of a coupon until the system is notified that the manufacturer's limit has been reached. In effect, the number of times for broadcasting a message/commercial containing that coupon can be interpreted as being determined to be zero when the requested/issued coupon limit has

been reached. Lemon et al also teaches a limit on the number of coupons redeemed [col 1 lines 61-62]. Holman also teaches that redemption histories be reported from the redeeming retailer to the manufacturer for intelligently making adjustments to its marketing campaigns [4:27-30, 18:59 to 19:5]. It would have been obvious to one of ordinary skill at the time of the invention to have reported such redemption usage to the system in order to enforce such a redemption limit on the proposed system of Holman in order to satisfy the manufacturer's desires.

Regarding claims 20, 23, 25, the delivery of the coupon data of Holman [is taken to be sent via a data broadcasting line.

Regarding claims 21, 24, 26, 27, it would have been obvious to one of ordinary skill at the time of the invention for a manufacturer to have increased its coupon issuance and/or redemption limits when a particular campaign is showing signs of strong, steady and legitimate coupon issuance/redemption so that a popular/profitable campaign can be extended. The suggestion that a manufacturer can make changes to its marketing efforts based upon redemption data [19:1-5] provides motivation for such a feature.

Regarding claims 28, 30, Kitsukawa et al teaches that the broadcast content information associated with the identified coupon includes title, air date/time and channel [11:48-54].

Regarding claim 31, Holman stores user information (taken to represent the audience at the receiver). Holman teaches storage of date/time of the broadcast related to each coupon. Official Notice is taken that accounting data regarding purchases

(purchasers gender, age, date/times of purchase, etc) are stored and used for marketing analysis and would have been obvious to one of ordinary skill at the time of the invention to have stored such data at the central host of Holman in order to carry out the desired marketing research and to provide reports of such analysis with respect to each type of data.

Regarding claims 32, 33, Kitsukawa et al teaches that program content is classified (i.e. identified) by the receiver's electronic program guide (EPG) [col 5 lines 32-35]. It would have been obvious to one of ordinary skill at the time of the invention to have used such identification data in order to notify the host of the program being watched in association with the requested coupon in order to enable the statistical analysis of coupons and programming as desired by Kitsukawa et al.

Response to Arguments

Applicant argues that Kitsukawa et al's statistical television data does not require determination of coupon issuance or redemptions. However, Lemon et al teaches setting limits on the number of issuances of coupons and Holman teaches limits on the number of redemptions, suggesting to one of ordinary skill to report to a host when these activities are requested so that the host may track and enforce the limits. Kitsukawa et al provides motivation for associating requested coupon activity with identified broadcast programming that accompanied the coupons in order to perform marketing analysis. Applicant argues that it "may be difficult to track issuances," yet the examiner believes the applied art provides motivation to do so, any difficulty aside.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc